



## REMARKS

Since the Examiner has withdrawn an on-going appeal after 2 years of prosecution for the purpose of entering a new rejection based on a new reference which the Examiner alleges anticipates Claim 1 applicant will deal first with this rejection before turning once again to the rejection based on the recapture rule.

The rejection of claims 1, 2 and 5 under 35 USC 102(b) as being anticipated by US Patent 5,503,062 to Buff IV is respectfully traversed.

The attached declaration under 37 CFR 1.132 explains why the Examiner's interpretation of Buff '062 is not only erroneous but not possible. As explained in detail in the declaration it is mechanically impossible for Buff '062 to be teaching the feature of "a plurality of offsets located either in the upright sections of the wire legs or in said first rim for laterally displacing each wire leg relative to said first rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging" as specified in claim 1 of the subject reissue application. Other reasons are set forth below and in the declaration for withdrawing Buff '062 as inapplicable.

As explained in paragraph (b) on page 4 of the declaration the statement of the Examiner that Buff IV '062 teaches in column 5 lines 13-16 and in lines 30-34 that the offsets "52" can facilitate nesting of a multiplicity of stands is erroneous and without support. In fact, Buff does not address or mention the subject of nesting of one stand into another and instead discusses only the nesting of the disposable aluminum foil roasting pan into the reinforcing assembly (the support structure). There is no teaching in Buff '062 which will support the Examiner's assertion.

In addition, and as explained in paragraph (a) on page 3 of the executed declaration, the alleged "off-sets" 52 in Buff '062 are formed by bending the upstanding frame support members (legs) 50 over the support wire 40 and therefore cannot possibly function to laterally displace each wire leg 50 relative to the wire 40 as called for in claim 1 of the subject reissue application. The reason for this is based on the fact Buff '062 only teaches the placement of the (bends) "offsets" 52 at opposite

longitudinal ends and not on the lateral sides of the support wire 40. Therefore the alleged offsets 52 in Buff '062 cannot function to laterally displace each wire leg 50 no matter how it is interpreted. Moreover, since claim 1 requires the offsets to be located either in the upright sections of the wire legs or in the first rim and since it is not possible for the offsets 52 in Buff IV '02 to be located in the first rim i.e. in the wire 40 itself this alone overcomes a rejection based on anticipation.

For each of the above reasons taken independently or in combination US Patent number 5,503,062 to Buff IV clearly does not anticipate claims 1, 2 and 5 of the subject reissue application under 35 USC 102(b). Furthermore as explained in paragraph (a) of the attached declaration of applicant it is mechanically impossible to nest a multiplicity of the "outer wire support frames 20" of Buff '062 into one another as is called for in claim 1. Accordingly even if the outer support frame 20 of Buff IV '062 were considered to be a "stand" it is not physically possible to nest a multiplicity of these frames 20 into one another nor is this contemplated in Buff '062. Therefore the rejection under 35 USC 102(b) is without merit and should be withdrawn.

As regards the rejection of the Examiner based upon the doctrine of "recapture" applicant has argued this issue heretofore at great length, and in the appeal brief of record. Unfortunately, from the analysis presented by the Examiner if an amendment is filed in a patent application the applicant can no longer reissue the patent to enlarge the claims. This is a totally incorrect interpretation of recapture and is not supported in the guidelines on pages 1-2 of the memorandum of the patent office dated August 4, 2003. The recapture rule is not designed to nullify the statute 35 USC 251 with regard to broadening reissue applications where an amendment was filed in the parent application. This is not the intent of the recapture rule. Clearly the Examiner has misinterpreted how to conduct an analysis under the recapture rule.

Claim 1 of the reissue application removes language relating only to the lower rim. The Examiner in the "first step" of the determination of the 3 step process for determining if recapture applies identifies the language which applicant deleted from claim 1 in the reissue application. In the "second step" on page 3 of the rejection the

Examiner indicates that an evaluation must be made to determine whether the broader aspects of the reissue claims relate to subject matter surrendered during prosecution of the patent. However, this requires an analysis to determine the surrendered subject matter and not an allegation or conclusion as to what subject matter has been surrendered. Broader language does not by definition constitute "surrendered subject matter."

The Examiner states that the "second step" of the "Pannu Test" requires a determination as to whether the broader aspects of the reissue claims relate to surrendered subject matter. The Examiner refers to an amendment filed by applicant during the patent prosecution dated July 26, 1999 in which claim 1 was amended. A copy of the exact submission of claim 1 as amended is as follows:

1. (As amended) A wire chafing stand comprising an upper rim of wire steel which forms a closed geometrical configuration circumscribing a first surface area, a lower rim of wire steel forming a closed geometric configuration circumscribing a second surface area with said surface area being larger than said second surface and having a plurality of wire legs [pair of wire legs of equal length affixed at one end thereof to the upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire leg such that the upper rim and lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the rim to uniformly support the stand at opposing ends thereof and having a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween.] with each wire leg having two upright sections interconnected to one another at a location below the lower rim in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90° with respect to a horizontal plane through said base support and being affixed to the upper rim adjacent one end thereof and to said lower rim at a relatively equal distance below the point of attachment to said upper rim and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said upper rim for

laterally displacing each wire leg relative to said upper rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging.

From the above the Examiner concludes that the changes to claim 1 were all made in an effort to narrow the claim and to overcome prior art. This conclusion is false. The changes were made both to broaden the claim as well as to narrow the claim to overcome prior art. It is self evident from the amended language that going from a "pair of wire legs of equal length affixed . . . to the lower rim at an equal location . . . such that the upper rim and lower rim lie in substantial parallel alignment to one another etc. . . ." to the language "a plurality of wire legs" and to language which does not specify "of equal length" and "at an equal location" and "such that the upper rim and lower rim lie in substantial parallel alignment" constitutes a substantial broadening of the claim relative to both the number of wire legs and to the omission of a relationship between the upper and lower rim. More importantly, all of the narrow language added by amendment to claim 1 (shown underlined above) except for the recitation and location of the lower rim relative to the wire legs remains intact in the reissue claims. Accordingly, both the broadened language and the narrow language of the above amended claim 1 except for the lower rim wording has not been touched in the filing of the reissue application.

The reference of the Examiner to page 4 of applicant amendment dated July 26, 1999 only support applicant's argument that the prior art was overcome solely based on the feature of nesting of a multiplicity of stands by means of "offsets". The Examiner is trying to provide a misleading interpretation of the wording on page 4. None of the lines referred to by the Examiner make the statement or permits the conclusion that the employment, configuration or construction of the lower rim has or had any relevance whatsoever to the cited reference Andrews or for overcoming the Andrews reference. If the entire page 4 of applicant is read it becomes quite clear that the allegation of the Examiner is without any support and is taken out of context.

The Examiner then concludes that the changes to the reissue claims relate to "surrendered subject matter." This is a naked conclusion which does not follow

from any of applicant's remarks during prosecution of the patent and is without merit. The Examiner has created a mechanical test for determining if subject matter has been surrendered and if changes to the reissue claims relate to the "surrendered subject matter." This mechanical test involves looking in the record to see if the broadened language in the reissue claims, i.e., terminology such as "lower rim," was used or mentioned in an amendment to the claims during the prosecution of the patent regardless of context and if so these words represent "surrendered subject matter" which cannot be further amended or deleted in a reissue application. A determination of "surrendered subject matter" and what relates to "surrendered subject matter" cannot be done in such a mechanical fashion devoid of logic and substance and is not in accordance with the second step of the "Pannu Test."

The proper application of the "second step" of the "Pannu Test" is to first determine what subject matter was surrendered during the prosecution of the patent and the relevance of the broadened language in the reissue claims to the such subject matter. This is a substantive test not a mechanical test. Throughout the prosecution of the patent the Examiner has taken the position, and still does, that the lower rim was a feature well known to the prior art and is not new. The references cited by the Examiner during the prosecution show and employ a lower rim. The location of a lower rim in the prior art wire chafing stands relative to wire legs was also admitted to be well known and not new. Moreover, the Examiner is not alleging that the deletion of the words "lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area" or its location and connection to the wire legs is subject matter which applicant argued was a limitation for overcoming prior art or that its presence was a limitation needed to overcome the prior art. In fact, the words in quotes were not amended during the prosecution of the patent. Instead the Examiner simply states that the broadened language in the reissue claims relate, by definition, to surrendered subject matter based on using the above mechanical test as the "Pannu Test." Applicant did not surrender any subject matter involving the lower rim geometry, location and/or function since this feature was not narrowed by amendment but was instead broadened or left unamended and was not a feature alleged by applicant to overcome the prior art. The surrendered subject matter relates to the language added

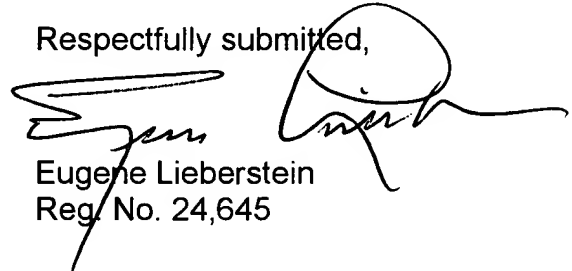
by amendment to overcome prior art, i.e., with each wire leg having two upright sections forming a base support for the stand to rest upon with each upright section extending to form an angle equal to or greater than ninety degrees with respect to a horizontal plane through the base support and further comprising the offset language all of which remains intact in the revised claims. It is this language upon which the Examiner allowed the application without any consideration of the "lower rim." The lower rim was not a factor in the allowance of the patent and does not relate to the surrendered subject matter. If a mechanical test is not used for the "Pannu" second step the record plainly and clearly shows that the broadened language in the reissue claims does not relate to surrendered subject matter.

The Examiner concludes on page 6 that the record of the original application shows that the broadening aspect of reissue claim 1 relates to subject matter Applicant previously surrendered. It is evident from the above this is not the case and no factual support has been presented to warrant this conclusion which would not automatically preclude filing a broadened reissue application in any situation in which an amendment had been filed to overcome prior art. The broadened language in the reissue claim 1 in connection with the "lower rim" does not relate to surrendered subject matter and should not preclude use of 35 USC 251.

Applicant once again requests the Examiner to withdraw the rejection of claims 1-5 and 7 under 35 USC 251 since the broadened language in the reissue claims do not relate to surrendered subject matter.

Since the Examiner has continued to reject this application based upon an erroneous interpretation of the recapture doctrine and has withdrawn an earlier appeal of this reissue application based on the same doctrine it is clear that the appeal will have to be continued. Accordingly attached hereto is another Notice of Appeal to facilitate the appeal process.

Respectfully submitted,

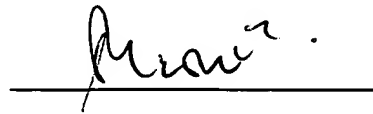


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#### MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 22, 2005.

 3/22/05